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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/648,923

08/27/2003

Anthony Dezonno

6065-86942

4105

24628

7590

01/24/2008

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

EXAMINER

HA, DAC V

ART UNIT

PAPER NUMBER

2611

MAIL DATE

DELIVERY MODE

01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,923

Applicant(s)

DEZONNO, ANTHONY

Examiner

Dac V. Ha

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the amendment filed on 12/05/07.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-50** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gregorek et al. (US 5,557,658) (hereafter Gregorek) in view of He (US 5,642,407).

Regarding claim 18, Gregorek discloses all claimed subject matter "means for suppressing at least one audio tone notifying a user of a receiving communications device that a connection is in the process of being established; and means for substituting information unrelated to the at least one suppressed audio tone to a user of the receiving communications device while the connection is in the process of being established" in Abstract; col. 2, line 62 to col. 3, line 12.

Gregorek differs from the claimed invention in that it doesn't teach the claimed subject matter "wherein the information is automatically configured based upon a profiled the user generated by monitoring the user's use of the communication device". However, in the same field of endeavor, He teaches such claimed subject matter in col. 1, lines 51-59; col. 3, lines 26-56; col. 4, line 46 to col. 8, line 12. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to

incorporate the teaching of automatically presenting advertisement to caller according to caller's "profile" into Gregorek to further optimize the efficiency of the advertisement.

Regarding claim 1, see claim 18 above. Further, He further suggests the teaching of the claimed subject matter "the information is downloaded during a completed communication immediately preceding the connection being established" in col. 3, line 26 to col. 6, line 58. That is, He stores records in the predicate table. These records relates to particular caller and are loaded during a connection is being established. Therefore, it would have been easily realized by one skilled in the art that those records could have included one "during a completed communication immediately preceding the connection being established".

Regarding claim 34, see claim 18 and similar analogy with that in claim 1 applies.

Regarding claims 30, 17, 35, see claim 1 above.

Regarding claims 19, 2, 36, Gregogrek further discloses "the information includes advertisements, music, movie clips, news headlines, sports scores, stock quotes, weather, time of day, calendar reminders, horoscopes, messages, and inspirational sayings" in col. 12, lines 17-27.

Regarding claims 20, 3, 37, Gregogrek further discloses "the information is conveyed in audio, visual, or audio-visual format to the user" in col. 12, lines 17-27.

Regarding claims 21, 4, 38, He further discloses "wherein the information comprises verbal messages describing the connection process" in Table 1.

Regarding claims 22, 5, 39, He further discloses "wherein the information ... display associated with the at least one communication device" in col. 6, lines 14-16.

Regarding claims 23-29, 31-33, 6-16, 40-50, these claimed subject matter would have been easily realized by one skilled in the art at the time of the invention as preference/application specific based on the aforementioned combination. That is, in the aforementioned combination, while establishing a connection, action is executed from an action list in relation to the caller attributes. He lists some of the action that could be taken in Table 1, however, there actions are merely examples, one skilled in the art would have easily realized that any other appropriate actions could have been included, depending each particular situation, so as to maximize the revenue generation during the time the connection is being established.

Response to Arguments

4. Applicant's arguments filed on 12/05/07 have been fully considered but they are not persuasive. (see explanation in the rejection above).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dac V. Ha whose telephone number is 571-272-3040. The examiner can normally be reached on 4/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Payne can be reached on 571-272-3024. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Dac V. Ha', with a long horizontal line extending to the right.

Dac V. Ha
Primary Examiner
Art Unit 2611